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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/690,512	10/17/2000	Eric C. Hannah	INTL-0482-US (P10030)	3230

21906 7590 04/18/2006

TROP PRUNER & HU, PC  
8554 KATY FREEWAY  
SUITE 100  
HOUSTON, TX 77024

EXAMINER

JANVIER, JEAN D

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 04/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/690,512		HANNAH ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Jean Janvier		3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

**After The Board Decision**

In a decision rendered on 03/18/2005, the Board had reversed the Examiner on all counts or claims. Thus, prosecution is herein being re-opened and a Non-Final Office Action follows.

**DETAILED ACTION**

***Specification***

**Status of the claims**

Claims 1-30 are currently pending in the Instant Application.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

As per claims 2, 5, 15 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 2, in the limitation "wherein accruing a credit includes allowing access to content" it is unclear whether the Applicant meant to refer to --providing free access to content to a customer in return for playing/viewing an advertisement- - or - -allowing the customer or user

to redeem a portion of the accrued or accumulated credits for a free access to content--. The claim will be broadly interpreted.

As per claims 5, 15 and 25, it is unclear how the watermark can help determine the speed at which the advertisement was played. In other words, important elements necessary for the understanding of the claim language are omitted therefrom. Thus, The claim will be broadly interpreted.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Rodriguez, US Patent 6,650, 761 B1

As per claims 1-30, Rodriguez discloses, inter alia, a system for watermarking content, such as a downloaded video or a transmitted advertisement, to thereby guarantee integrity of the downloaded content or transmitted advertisement upon receipt and to correctly bill the recipient

Art Unit: 3622

of the video content for what was actually received as opposed to what was transmitted or downloaded.

Furthermore, watermark technology is used to track and verify proper delivery of content including advertising content. In one application of this technology, recipients of advertising content, such as TV subscribers, computer users (identified users), are provided incentives for viewing advertising in its entirety. For example, a content-receiving device, such as a computer, can include a watermark detector that issues a receipt for each watermarked advertisement that is heard/viewed in its entirety (providing accrued incentives or accumulated rewards to an identified user of a computer or a set-top-box for listening to played or viewing displayed watermarked advertisements). These receipts may be redeemed, for example, for content tokens (type of currency), for monetary value, etc. In some embodiments, receipts are generic and can all be applied to a desired premium, regardless of the advertisements through which they were earned. In other embodiments, the receipts are associated with the particular advertisers (or class of advertisers). Thus, an identified or a specific TV viewer who accumulates 50 receipts (accrued rewards) for hearing/viewing advertising originating from Procter & Gamble may be able to redeem them for a coupon good for \$2.50 off any Procter & Gamble product, or accrued or accumulated receipts from Delta Airlines may be redeemed for Delta frequency flier miles (e.g., at a rate of one mile per minute of advertising heard/viewed). Such incentives are particularly useful in new forms of media that give the consumer enhanced opportunities to fast-forward or otherwise skip advertising (col. 57: 65 to col. 58: 34).

Art Unit: 3622

(Col. 44: 17 to col. 45: 22; col. 24: 23-37; col. 54: 26-54; col. 55: 35 to col. 56: 19; col. 57: 9 to col. 58: 34).

### Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent 6, 216, 112B1 to Fuller discloses a method and system for distributing free software, having advertisements embedded therein, to customers and compensating the authors of the software for every copy of the software illegally distributed by collecting payments from advertisers or sponsors whose advertising messages are inserted in the said software to be displayed on the customer's or user's PC screen. The software or application software, downloaded over the Internet from a web site related to a computer server 102 of fig. 1 or shipped to a user on a floppy disk or a CD ROM (Media player) to be installed on the user's PC 110 of fig. 1, is executed by the user on his PC 110 of fig. 1 subsequent to installing the software on his computer hard disk (See abstract; col. 2: 30-32). **Here, the user has restricted rights to the free software and thus, he must occasionally or periodically read advertising messages whenever he executes the said software or before using the software.**

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (571) 272-6719. The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner

Application/Control Number: 09/690,512

Page 6

Art Unit: 3622

by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (571) 272- 6724.

Non-Official- 571-273-6719.

Official Draft : 571-273-8300

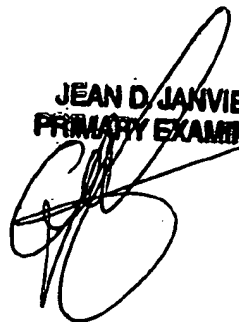
01/27/06

JDJ

Jean D. Janvier

Patent Examiner

Art Unit 3622

  
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